



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/265,307 03/09/99 WEBB

N N0260/7031 (E)

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HM12/0721

EXAMINER

TRINH, B

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

07/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/265, 307

Applicant(s)

NIGEL et al

Examiner

TRINH

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4-14-00.
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 1, 5, 7, 11-12, 17, 21, 23, 28, 33, 48-49, 55-57, 62, 65, 69-70, 75,  
78, 82, 84, 87-90, 94, 97, 101, 103, 107-108, 110, 114
- ☒ Claim(s) 1, 5, 7, 11-12, 17, 21, 23, 28, 33, 48-49, 55-57, 62, 65, 69-70, 75, 78, 82, 84, 87-90, 94, 97, 101, 103, 107-108, 110, 114 is/are pending in the application.
  - ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - ☐ Claim(s) \_\_\_\_\_ is/are allowed.
  - ☒ Claim(s) above. is/are rejected.
  - ☐ Claim(s) \_\_\_\_\_ is/are objected to.
  - ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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Claims 1, 5, 7, 11, 12, 17, 21, 23, 28, 33, 48, 49, 55-57, 62, 65, 69, 70, 75, 78, 82, 84, 89, 90, 94, 97, 101, 103, 107, 108, 110 and 114 are pending.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 U.S.P.Q. 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 U.S.P.Q. 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 7, 11, 12, 17, 21, 23, 28, 33, 48, 49, 55-57, 62, 65, 69, 70, 75, 78, 82, 84, 89, 90, 94, 97, 101, 103, 107, 108, 110 and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,919,815 (Bradley et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant taxane embraces the taxol species and the fatty acid embraces the docosahexaenoic acid as a species.

Applicant's remarks filed on April 14, 2000, had been considered. The art rejection had been withdrawn. The instant composition contains polyox<sup>y</sup>ethylated castor oil which had been

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taught by Bradley et al.; note lines 32-41, col. 17, of the patent, as a common carrier, thus, the claimed composition would be obvious over the patented composition.

No claim is allowed.

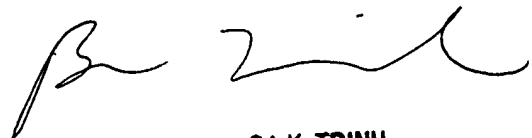
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Ba Trinh at telephone number (703) 308-4145.

BT/pam

7/9/00



BA K. TRINH  
PRIMARY EXAMINER  
GROUP ~~1200~~ 1625